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HDP/SB/21 based on PTO/SB/21 (08-00)

AF 13711
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/017,959	RECEIVED
Filing Date	February 3, 1998	MAY 30 2002
First Named Inventor	David A. Bernhardt	
Group Art Unit	3711	
Examiner Name	William M. Pierce	TECHNOLOGY CENTER R3700
Total Number of Pages in This Submission	1	Attorney Docket Number

Total Number of Pages in This Submission

Attorney Docket Number

8117-0000021

ENCLOSURES (check all that apply)

- Fee Transmittal Form
- Fee Attached
- Amendment / Response
 - After Final
 - Affidavits/declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement
- Certified Copy of Priority Document(s)
- Response to Missing Parts/ Incomplete Application
 - Response to Missing Parts under 37 CFR 1.52 or 1.53

- Assignment Papers (for an Application)
- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s) _____

- After Allowance Communication to Group
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter

Other Enclosure(s)
(please identify below):

Reply Brief

Remarks

The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

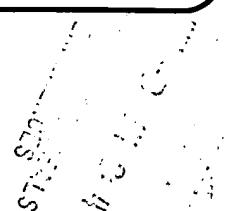
TECHNOLOGY CENTER R3700

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name W. R. Duke Taylor	Reg. No. 31,306
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Date	May 21, 2002		

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Typed or printed name	W. R. Duke Taylor	Date	May 21, 2002
Signature		Date	May 21, 2002



FEE TRANSMITTAL for FY 2002

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Complete if Known	
Application Number	09/017,959
Filing Date	February 3, 1998
First Named Inventor	David A. Bernhardt
Examiner Name	William M. Pierce
Group / Art Unit	3711
Attorney Docket No.	8117-000021

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 TECHNOLOGY CENTER R3700

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Harness, Dickey & Pierce, P.L.C.

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
SUBTOTAL (1)				(\$ 0)	

2. EXTRA CLAIM FEES

Total Claims	-20 **	= 0	Extra Claims	Fee from below	Fee Paid
Independent Claims	-3 **	= 0			
Multiple Dependent					

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)				(\$ 0)

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)					
Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	
				Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	140
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17 (q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify) _____					
*Reduced by Basic Filing Fee Paid				SUBTOTAL (3)	(\$ 140)

SUBMITTED BY					
Complete if applicable					
Name (Print/Type)	W. R. Duke, Jr.	Registration No. Attorney/Agent	31,306	Telephone	(248) 641-1600
Signature	<i>W. R. Duke, Jr.</i>			Date	May 21, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art:

3711

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Examiner: William M. Pierce

REPLY BRIEF

Applicant: David A. Bernhardt

Serial No.: 09/017,959

Filed: February 3, 1998

For: **BOWLING BALL FINGER GRIP**

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Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

MAY 30 2002

TECHNOLOGY CENTER R3700

Dear Sir:

In response to the Examiner's Answer, please consider the following.

Applicant respectfully requests an Oral Hearing and encloses the requisite fee under 37 C.F.R. 1.17(d) in the amount of \$140.00.

The Examiner continues to misapply the two prong tests set forth in In Re Paulsen 31 U.S.P.Q. 2d 1671 at 1673 (Fed. Cir. 1994). The Court stated that

"a rejection for anticipation under §102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Spada, 911 F.2d 705, 708 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990). In addition, the reference must be enabling and describe the Applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." Id.

The Examiner has failed to show that the Stevens reference having its pointed projections in any way disclose anything other than brushing teeth. It neither discloses nor suggests projections with the desired configurations such that the tips of the projections define a curve which has a curvature substantially like the curvature of a bowling ball when force is exerted by a bowler on the ball. The Examiner suggests that it is inherent that Stevens shows these features. Clearly this is not the case. In re Weiss 26 U.S.P.Q. 2d 1885 (Fed. Cir. 1993) at 1888 the court

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stated:

“the mere fact that a certain thing may result from a given set of circumstances is not sufficient (to establish inherency)...” (which requires that) the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function....

Here the Examiner is misapplying Stevens since its disclosure, or lack of it, only discloses a tooth brush. Stevens shows brushing teeth and does not teach the result of applying spin on a bowling ball. Thus, Stevens does not inherently disclose Applicant’s invention.

With respect to the second part of the test, Stevens is not sufficient to have placed Applicant’s invention in possession of a person of ordinary skill in the field of the invention. The Examiner states that the field of the invention is finger cots. Applicant has attached a print out from Dictionary.com which indicates that no entries were found for the term “finger cot”. A further search on Yahoo illustrates that finger cots are for handling small parts and for protecting delicate parts from salts and oils associated with the skin. The finger cots are illustrated as very thin latex members, they have no projecting members. The Examiner alleges that the problem at hand is improving grip and protecting the fingers and not bowling per se. Clearly this is incorrect. As stated in Applicant’s application, the purpose of the finger grip is to impart spin onto the bowling ball. Not for protection as alleged by the Examiner. Further the claims are directed to bowling accessories and finger grips. In fact, no where has the Examiner brought forth any reference illustrating a finger cot which a bowler has used to protect his fingers or improved grip. Thus, the Examiner’s argument is flawed with error.

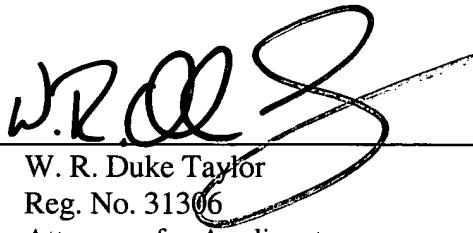
Conclusion

Applicant respectfully submits that the Examiner’s anticipation rejection is improper. The Examiner has failed to provide a reference which meets both parts of the above identified

test. Accordingly, Applicant believes Claims 17 through 28 to be patentable over the cited art and respectfully requests allowance of the same.

Respectfully submitted,

Dated: May 21, 2002

BY: 
W. R. Duke Taylor
Reg. No. 31306
Attorneys for Applicant

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WRDT/jp
Enclosure

Attorney Docket No. 8117-000021

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